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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,330	01/22/2001	Scott Thomas Molloy	14013-29US	9338

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EXAMINER

SAM, PHIRIN

ART UNIT PAPER NUMBER

2661

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,330

Applicant(s)

MOLLOY, SCOTT THOMAS

Examiner

Phirin Sam

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,10-15,17,19-22 and 24 is/are rejected.
- 7) ☒ Claim(s) 3,4,7-9,16,18 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

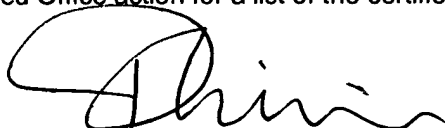
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



PHIRIN SAM

PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 10-15, 17, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,809,415 (hereinafter referred as “Rossmann”).

Rossmann discloses the invention (**amended claims 1, 13, and claim 14, 15**) as claimed including an ARPA-Internet network access/service provider device comprising:

- (a) a fax gateway including,
- (b) a storage device for storing an email message received from an email sender for transmission to a fax recipient through a packet switching network (see Figs. 1, 5, and 7, element 755, col. 26, lines 49-52), the stored email message to be converted to a fax document for transmission thereof to the fax recipient having access to a fax device (see Fig. 1, element 121, col. 15, lines 35-43, col. 26, lines 60-64);
- (c) at least one fax modem device for transmitting the fax document to the fax recipient through a public switching network (see Fig. 5, col. 15, lines 40-43, wherein a fax gateway must have a fax modem in order to send/receive the fax document to the fax recipient);
- (d) wherein a fax number designating the fax recipient is not contained in the email message (see Fig. 1 and 5, col. 15, lines 40-43).

Regarding amended claim 2, Rossmann discloses the storage device further can store a fax telephone number associated with the fax device of the fax recipient, the fax telephone number to be used to establish a call for the transmission of the fax document (see Figs. 5 and 7, element 755, col. 24, lines 35-38, col. 26, lines 49-53).

Regarding claim 10, Rossmann discloses the fax gateway is coupled to the public switching telephone network (see Fig. 1, elements 112 and 121, col. 15, lines 36-45).

Regarding claims 11 and 12, Rossmann discloses the fax gateway is coupled to the public switching telephone network through a digital communication link (see Fig. 1).

Regarding amended claims 17, 21, and 22, Rossmann discloses a method for sending and receiving email messages using a fax device comprising:

- (a) receiving an e-mail message through a data communications network from an e-mail sender (see Fig. 1, col. 15, lines 36-38);
- (b) converting the e-mail message into a fax document (see Fig. 1, col. 15, lines 40-43);
- (c) transmitting the fax document to a fax recipient without extracting a fax number from the e-mail message thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Fig. 1, col. 15, lines 442-43).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 5, 6, 19, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,809,415 (hereinafter referred as "Rossmann") in view of US Pub. 2004/0218226 (hereinafter referred as "Antoginini").

Regarding claim 5, Rossmann does not disclose creating a fax cover page for transmission to the fax recipient. However, Antoginini discloses creating a fax cover page for transmission to the fax recipient (see Fig. 2, paragraph [0062]). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine creating the fax cover page teaching by Antoginini with Rossmann. The motivation for doing so would have been to provide to identify the recipient of the fax and the information identifying the sender read on paragraph [0005]. Therefore, it would have been obvious to combine Antoginini and Rossmann to obtain the invention as specified in the claim 5.

Regarding claims 6, 19, 20, and 24, Rossmann does not disclose the e-mail message includes an e-mail address and the fax cover page includes a sender field extracted from the e-mail address. However, Antoginini discloses the e-mail message includes an e-mail address and the fax cover page includes a sender field extracted from the e-mail address (see Fig. 2, paragraph [0045]). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the e-mail message includes an e-mail address and the fax cover page includes a sender field extracted from the e-mail address teaching by Antoginini with Rossmann. The motivation for doing so would have been to provide to identify the sender read on paragraph [0005]. Therefore, it would have been obvious to combine Antoginini and Rossmann to obtain the invention as specified in the claims 6, 19, 20, and 24.

Allowable Subject Matter

5. Claims 3, 4, 7-9, 16, 18, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 2, 5, 6, 10-15, 17, and 19-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) US Patent 6,857,007 (Bloomfield) discloses personal digital assistant facilitated communication system.

(2) US Patent 6,424,426 (Henry) discloses fax-to-email and email to fax communication system and method.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phirin Sam whose telephone number is (571) 272-3082. The examiner can normally be reached on a compress schedule, from 8:00-5:30, first Wed off.

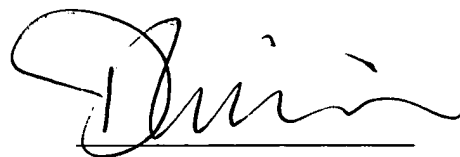
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on (571) 272 - 3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully submitted,

Date: November 22, 2005

A handwritten signature in black ink, appearing to read 'Phirin Sam', written over a horizontal line.

**PHIRIN SAM
PRIMARY EXAMINER**